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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,522	12/08/2003	Ashok R. Thakrar	D-4104	2978
33197	7590	12/22/2004	EXAMINER	
STOUT, UXA, BUYAN & MULLINS LLP 4 VENTURE, SUITE 300 IRVINE, CA 92618			SCHWARTZ, JORDAN MARC	
			ART UNIT	PAPER NUMBER
			2873	

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/730,522

Applicant(s)

THAKRAR, ASHOK R.

Examiner

Jordan M. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,7,8,10-20,22-29 and 36-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 36 is/are allowed.
- 6) ☒ Claim(s) 1,2,5,7,11-20,22,23,25-27,29,38,39,41 and 42 is/are rejected.
- 7) ☒ Claim(s) 8,10,24,28,37 and 40 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Claim Rejections - 35 USC § 112***

Claims 22, 39 and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22 states that it is dependent from claim 21, however, claim 21 has been cancelled and therefore the intended dependency of claim 22 is not known rendering the claim vague and indefinite. For purposes of examination it is assumed that claim 22 meant to depend from claim 17.

With respect to claims 39 and 42, applicant is claiming "wherein the precursor" which renders these claims vague and indefinite for the following reason. Specifically, claims 1 and 17, from which claims 39 and 42 depend, claim the image component disposed to or on "the lens body, or to a precursor thereof". It is therefore not clear if claims 39 and 42 are attempting to claim "wherein the image component is initially provided to a precursor of the lens body in a liquid binder material comprising particles of a multilayered interference film that is substantially absent of any intrinsic color, wherein the precursor is a lens forming material provided in a contact lens mold" (which is the assumed meaning for purposes of examination) or if applicant is claiming that the image component is initially provided to the lens body, or a precursor thereof, in a liquid binder material...but regardless, a precursor of the lens is a lens forming material provided in a contact lens mold (i.e. a precursor of the lens is a lens forming material in a contact lens mold but the lens material in the mold for the precursor

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need not be the liquid binder material etc). The lack of clarity renders the claims vague and indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 5, 7, 11-13, 15, 17-20, 22, 25-26, 29, 38-39, 41-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Quinn et al patent number 6,196,683.

Quinn et al'683 reads on these claims by disclosing the limitations therein including the following: a contact lens (abstract); a lens body having an optical region (Figure 1, column 1, line 8 to column 2, line 46,). A contact lens will inherently have an anterior and posterior surface since it will inherently have a surface in contact with the eye of a user and a second object side surface. Quinn'683 further discloses an image component disposed on or within the lens body being effective in producing a color shifting appearance (as this term is defined on pages 2-3 of applicant's specification re Quinn'683, column 2, lines 32-42, column 3, line 63 to column 4, line 2 in that the pearlescent containing material is the image component and a "metallic foil appearance" will cause an object to exhibit the property of changing color upon variation of an angle of

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incidence or upon the viewing angle of an observer). Quinn et al'683 further discloses the image component initially provided to the lens body or a precursor thereof (column 2, line 66 to column 3, line 10, column 4, line 66 to column 5, line 7); in a liquid binding material (column 4, lines 20-29, column 4, line 66 to column 5, line 6); comprising particles of a multilayered interference film (column 3, lines 54-62 re the pearlescent pigments will inherently contain particles, multilayered in that the platelets form multiple layers in the coating, column 3, line 64 re "interference" and claim 35 re the multiple interference layers as a film); and being substantially absent of any intrinsic color (column 3, lines 54-62 re the mica platelets as "transparent" and "may also" contain colorant pigment i.e. colorant pigment is not required).

The image component of Quinn et al'683 will inherently comprise a light diffractive component, this being reasonably based upon Quinn et al'683 disclosing the component producing light interference (column 3, line 64). Quinn et al'683 further discloses binder material comprising a polymeric material (column 4, line 66 to column 5, line 6); also including particles of a reflective film (column 3, line 57); the image component as a layer on the anterior surface of the lens body (column 4, line 20 to column 5, line 6); or integrated into the lens body (column 2, line 66 to column 3, line 10). The particles of Quinn et al will inherently have a size as claimed in claims 5, 22, 38, and 41, this being reasonably based upon the different types of pearlescent pigments that Quinn et al'683 discloses can be used within the invention (column 3, line 54 to column 4, line 13). The image component of

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Quinn et al'683 will inherently produce a rainbow colored spectral appearance, this being reasonably based upon Quinn et al'683 disclosing that the image component can provide a "metallic foil looking appearance" (column 3, line 64 to column 4, line 2). Quinn et al'683 further discloses the image component provided as an annulus on a surface of the lens (Figure 1); the image component disposed between the anterior and posterior surface of the lens (column 4, lines 20-29, column 4, line 66 to column 5, line 6); and the image component further comprising at least one non-diffractive colorant (column 3, line 56); the non-diffractive colorant comprising a colored ink printed on the lens body (column 3, line 56 to column 4, line 60); the image component provided as a pattern of an iris of an eye (Figure 1); and the image component is initially provided to a precursor of the lens body, wherein the precursor is a lens forming material provided in a contact lens mold (column 2, line 66 to column 3, line 10, column 4, lines 20-29, claim 35).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14, 16, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quinn et al'683 in view of Quinn et al publication number 2003/0054109.

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In reference to claims 14 and 27, Quinn et al'683 discloses as is set forth above including the binder material forming an ink to be printed onto the surface of a contact lens (column 2, line 66 to column 5, line 6) but does not specifically disclose the ink expelled from an ink jet printer or comprising a plurality of ink pixels. Quinn'109 teaches that in forming colored contact lens by ink printing (abstract) that it is desirable to have the ink component printed through the use of an inkjet printer for the purpose of providing a coloring of improved quality and adhesion to the lens (paragraphs 0007-0008, 0027). An inkjet printer will inherently print "a plurality of ink pixels" since such printing method inherently provide the colorant onto a surface through a pixilated image. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the ink printed colorant of Quinn'683 as being applied through inkjet printing of a plurality of ink pixels since Quinn'109 teaches that in forming colored contact lens by ink printing, that it is desirable to have the ink component printed through the use of an inkjet printer for the purpose of providing a coloring of improved quality and adhesion to the lens.

In reference to claim 16, Quinn et al'683 discloses as is set forth above including that the pearlescent pigment can include "a conventional colorant pigment" (column 3, line 56) but does not disclose the use of a phosphorescent pigment material. Quinn'109 teaches that in forming colored contact lens by ink printing (abstract) that it is desirable to use a phosphorescent pigment for the purpose of producing a contact lens that also has a luminescence effect (paragraphs 0035 and 0038). Therefore, it would have been obvious to a person

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of ordinary skill in the art at the time the invention was made to have the contact lens of Quinn'683 as further comprising a phosphorescent pigment material since Quinn'683 discloses that the lens can further include any conventional colorant pigment and since Quinn'109 teaches that in forming colored contact lens it is desirable to use a phosphorescent pigment for the purpose of producing a contact lens that also has a luminescence effect.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Quinn et al'683 in view Doshi publication number 2002/0030788.

Quinn et al'683 discloses as is set forth above but does not disclose an outer optically clear polymeric layer. Doshi'788 teaches that in a contact lens with a printed image thereon, that it is desirable to further include an outer optically clear polymeric layer for the purpose of producing a laminate structure of improved image durability and quality (paragraphs 0009 and 0228). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the contact lens of Quinn et al'683 as further comprising an outer optically clear polymeric layer since Doshi'788 teaches that in a contact lens with a printed image thereon, that it is desirable to further include an outer optically clear polymeric layer for the purpose of producing a laminate structure of improved image durability and quality.

Allowable Subject Matter

Claim 36 is allowed.

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Claims 8, 10, 24, 28, 37, and 40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: with respect to the allowable subject matter, none of the prior art either alone or in combination disclose or teach of the claimed combination of limitations to warrant a rejection under 35 USC 102 or 103. Specifically, with reference to claim 8, none of the prior art either alone or in combination, disclose or teach of the claimed contact lens specifically including, as the distinguishing feature in combination with the other limitations, the polymeric material comprising the specific co-polymers as claimed. Specifically, with reference to claim 10, none of the prior art either alone or in combination, disclose or teach of the claimed contact lens specifically including, as the distinguishing feature in combination with the other limitations, each of the claimed films being effective in exhibiting a different light interference property. Specifically, with reference to claim 24, none of the prior art either alone or in combination, disclose or teach of the claimed contact lens specifically including, as the distinguishing feature in combination with the other limitations, the image component structured to create a three-dimensional appearance of at least a portion of an eye. Specifically, with reference to claims 28 and 36, none of the prior art either alone or in combination, disclose or teach of the claimed contact lens specifically including, as the distinguishing feature in combination with the other limitations, the claimed portion of the ink pixels as bleached. Specifically, with reference to claim 37 and

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40, none of the prior art either alone or in combination, disclose or teach of the claimed contact lens specifically including, as the distinguishing feature in combination with the other limitations, the particles having been combined with a passivator before being provided on the lens body.

Response to Arguments

Applicant's arguments with respect to the above rejected claims have been considered but are moot in view of the new ground(s) of rejection set forth above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

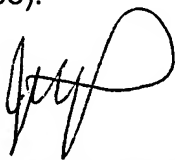
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (571) 272-2337. The examiner can normally be reached on Monday to Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jordan M. Schwartz
Primary Examiner
Art Unit 2873
December 17, 2004